

REMARKS

By the present Amendment, claim 13 has been amended to correct an obvious textual omission. No new matter has been added. As a result of this Amendment, claims 1-19 remain pending.

In the last Office Action dated February 23, 2004, the Examiner rejected claims 1-19 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 6,140,832 to Vu et al. (*Vu*) in view of U.S. Patent No. 5,381,103 to Edmond et al. (*Edmond*).

Applicant respectfully disagrees with the Examiner's arguments and conclusions and respectfully traverses the 35 U.S.C. §103(a) rejection for the following reasons.

"To establish *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." See M.P.E.P. §2143 (8th Ed. 2001, revised in February, 2003). It bears emphasizing that this requirement must be found in prior art - not based on Applicants' own disclosure. See *id.*

Applicant respectfully submit that a *prima facie* case of obviousness has not been made because the Examiner did not show that all the elements of Applicant's claims 1-19 are met in *Vu* and *Edmond*, taken alone or in combination. The Examiner also did not show that there is any suggestion or motivation to modify the cited references to result in the claimed invention nor a reasonable expectation of success in doing so, as are also required in order to properly support a *prima facie* case of obviousness.

Vu describes a method of using IDDQ testing to screen out defective integrated circuit devices. *Vu*, col. 1, lines 6-7. According to *Vu*, after a tester loads parametric test data derived from the test into a database, pre-stress and post-stress functional tests are performed and the results also loaded into a database. *Vu*, col. 2, lines 1-8.

Present claim 1 recites, among other things, a semiconductor testing apparatus for testing semiconductor devices, configured to feed back data of returned samples which have been shipped as good samples, but returned from a user to a manufacturer as faulty samples.

Nowhere does *Vu* teach or suggest at least “[feeding back data] of returned samples which have been shipped as good samples, but returned from a user to a manufacturer as faulty samples,” as recited in present independent claim 1. And the Examiner acknowledged this shortcoming of *Vu*. See Office Action dated February 23, 2004, p. 6, line 8. Further, contrary to the Examiner’s assertion, adding *Edmond* does not cure *Vu*’s deficiencies.

Edmond, the reference the Examiner newly cited in the last Office Action, describes a method of testing a semiconductor device by accelerating degradation of the semiconductor devices and measuring various performance characteristics. *Edmond*, col. 3, lines 5-7. *Edmond*’s method of testing consists of pulsing a semiconductor device with a predetermined level of current to cause inadequate devices to degrade and adequate devices to stabilize. According to *Edmond*, optical

and/or electrical characteristics of a semiconductor device is measured before, during, and after the current pulse. *Edmond*, col. 3, lines 10-16.

Contrary to the Examiner's assertion, *Edmond* does not disclose "the samples returned by the user in order to have a good performance products." See Office Action of February 23, 2004, p. 6, lines 8-10. In fact, nowhere does *Edmond* teach or suggest at least "[feeding back data of] returned samples which have been shipped as good samples, but returned from a user to a manufacturer as faulty samples, as recited in present independent claim 1.

Moreover, *Edmond* teaches away from the present invention because according to *Edmond*, "manufacturers desire good performance of devices to build device reliability, prevent returns, and reduce service calls by the manufacturer." *Edmond*, col. 1, lines 10-21 (emphasis added). In other words, *Edmond* discloses the testing of semiconductor devices prior to their shipping to users in an attempt to prevent returns of semiconductor devices by users, reduce service calls by manufacturer, and generally prevent customer dissatisfaction.

In contrast, according to the current invention, a statistical analysis using semiconductor products which once were considered as good products and shipped to users but then returned to the manufacturer as defective is performed. Thus, according to the present invention, defects in the samples returned by the user are examined after being sent back to the manufacturer.

Therefore, the references cited by the Examiner, *Vu* and *Edmond*, taken alone or in combination, fail to teach or suggest each and every element recited in claim 1. Finally, neither *Vu* nor *Edmond* provides any motivation or suggestion to combine their teachings nor there is a reasonable expectation of success in doing so and the Examiner has identified none. Thus, the section 103(a) rejection is improper and must be withdrawn.

Present independent claims 5, 9, 13, 16, and 19, while of different scope, contain similar recitations to present claim 1. Therefore, for at least reasons given above with respect to claim 1, the combination of *Vu* and *Edmond* fails to teach or suggest each and every element of claims 5, 9, 13, 16, and 19. Thus, Applicant respectfully requests reconsideration and withdrawal of the section 103(a) rejections of claims 5, 9, 13, 16, and 19.

Present claims 2-4 depend from claim 1, claims 6-8 ultimately depend from claim 5, claims 10-12 ultimately depend from claim 9, and claims 14, 15, 17, and 18 ultimately depend from claim 13. For at least the reasons given above with respect to independent claims 1, 5, 9, 13, 16, and 19, the combination of *Vu* and *Edmond* fails to teach or suggest each and every element of claims 2-4, 6-8, 10-12, 14, 15, 17, and 18. Thus, Applicant respectfully requests reconsideration and withdrawal of the section 103(a) rejections of claims 2-4, 6-8, 10-12, 14, 15, 17, and 18.

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

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Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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